

**REMARKS**

Claims 1-23 are pending in this application. By this Amendment, claims 1, 5, 6, 12 and 23 are amended. Claim 6 is amended only to correct an indefinite article. No new matter is added. Reconsideration of the application is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Vaughn in the April 26, 2005, personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

**I. Specification Objection**

The Office Action objects to the specification as introducing new matter. Specifically, the Office Action asserts that the recitation of "the switch in a first predetermined position" and "the switch in a second predetermined position" constitutes new matter which is not supported by the original disclosure. Applicant respectfully traverses the objection.

As an exemplary embodiment, the specification discloses markers 101A, 101B including a tip 204 that moves vertically as a result of pressure in order to trigger a switch 201 that is set "on" when the tip is pressed against a recording sheet 103 and "off" when the pressure is released, as supported by specification, page 5, paragraph [0015]. Therefore, the specification provides ample support for a switch in first and second predetermined positions.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection.

Claims 1, 5, 12 and 23 are amended to recite a "first position" and a "second position" for further clarification. However, the claims are not narrowed by these amendments.

During the personal interview, the Examiner agreed that the specification provides ample support for the recitation of "the switch in a first predetermined position" and "the switch in the second predetermined position." Therefore, the Examiner agreed to withdraw the objections related to new matter. Further, the Examiner agreed that amendments to claims 1, 5, 12 and 23 to recite a "first position" and a "second position" further clarify the claims.

## **II. Rejection Under 35 U.S.C. §102(b)**

The Office Action rejects claims 1-23 under 35 U.S.C. §102(b) over U.S. Patent No. 5,717,879 to Moran et al. ("Moran"). Applicant respectfully traverses the rejection.

Moran does not disclose an information recording and reproducing apparatus including a handheld playback selecting device "that outputs a playback start signal of the sound data with the switch in a first position and a playback end signal of the sound data with the switch in a second position," and a sound data playback device in which "the sound data playback device continues the playback of the sound data so long as the switch of the playback selecting device is in the first position," as set forth in independent claims 1, 5 and 23 or "that plays back sound data stored from the input time of a writing information unit till the input time of a next writing information unit," as set forth in claim 12.

During the personal interview, the Examiner requested that Applicant specify where support for such claim features can be found in the application. Support for these features can be found at least in Figs. 7-9, and paragraphs [0048], [0057], [0067] and [0068].

The Office Action asserts that Moran discloses reference signs 304 and 305 in Fig. 3, a LiveBoard Window 1601 in Fig. 16 and a mouse as a playback selecting devices (col. 27,

lines 19-23). Further, the Office Action asserts that it is well known in the art that a mouse is equipped with a switch/mouse button. Notwithstanding these assertions, Moran does not disclose a handheld playback selecting device that outputs a playback start signal and a playback end signal with the switch in first and second positions, respectively, and a sound data playback device that continues the playback of the sound data so long as the switch of the playback selecting device is in the first position, as set forth in claims 1, 5 and 23 or that plays from an input time of a writing information unit until the input time of a next writing information unit, as set forth in claim 12.

Moran discloses a session access workstation 105 that operates using program instructions for playback and control which includes operations setting a play state to "play" as shown in box 304 and setting a play state to be set to "stop" as shown in box 305 in response to a command or a equivalent graphical user interface input, e.g., clicking on a particular icon (Fig. 3, and col. 17, lines 18-20 and 41-49). Therefore, reference numerals 304 and 305 refer to operational commands of the session access workstation 105, not a handheld playback selecting device.

Moran also discloses that the session access workstation 105 is typically a computer controlled display system that controls session playback through a graphical user interface presented on a display (col. 13, lines 55-58). The session access workstation 105 is integrated within or coupled to a player, playback controller, and/or editor to play back an electronic whiteboard timestream through a window on the workstation and an audio timestream via an audio subsystem of the workstation (col. 13, line 64 - col. 14, line 8). As an example of a player, playback controller, and/or editor coupled to the session access workstation 105, Moran discloses a LiveBoard™ including a Live-Board Window 1601 (col. 24, lines 22-24). The LiveBoard™ is an electronic whiteboard that serves as a capture device 102A that

captures and stores temporal data, e.g., writings on a whiteboard (Fig. 1, col. 6, lines 35-38, and col. 12, lines 55-61).

In order to replay a conversation when a word was written, Moran discloses that a user selects a word 1602 in an area of a screen of the Live-Board Window 1601 by appropriately positioning a cursor and quickly depressing and releasing a button/switch associated with the cursor control device, e.g., mouse (Fig. 16, and col. 5, lines 58-64). Further, Moran teaches that other operations may require a "double click" where the button/switch is depressed and released rapidly, twice in succession (col. 5, lines 58-64). Therefore, playback of data starts after the mouse button is pressed and released and continues until the mouse button is pressed and released again. The playback of data is not conditioned on a continuous pressed state of the mouse button (claims 1, 5 and 23) or plays from an input time of a writing information unit until the input time of a next writing information unit (claim 12).

Because the mouse button is not continually pressed to playback sound data, Moran does not disclose, teach or suggest a handheld playback selecting device "that outputs a playback start signal of the sound data with the switch in a first position and a playback end signal of the sound data with the switch in a second position" and a sound data playback device in which "the sound data playback device continues the playback of the sound data so long as the switch of the playback selecting device is in the first position," as set forth in claims 1, 5 and 23 or from an input time of a writing information unit until the input time of a next writing information unit as set forth in claim 12. For at least the foregoing reasons, Moran fails to disclose each and every element of claims 1, 5, 12 and 23.

Therefore, claims 1, 5, 12 and 23 are patentable over Moran. Claims 2-4, 6-11 and 13-22 variously depend from claims 1, 5 and 12, and thus also are patentable over Moran for at least the reasons set forth above, as well as for the additional features they recite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-23 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Holly N. Moore  
Registration No. 50,212

JAO:HNM/ale

Date: May 2, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

**DEPOSIT ACCOUNT USE  
AUTHORIZATION**

Please grant any extension  
necessary for entry;  
Charge any fee due to our  
Deposit Account No. 15-0461